Atty. Docket No. 25063.0002

#19 Ddc 5/14/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Timothy P. COLEMAN et al.

Serial Number: 09/495,947 Group Art Unit: 1632

Filed: 02 February 2000 Examiner: Li, Qian J.

For: ADVANCED ANTIGEN PRESENTATION PLATFORM

REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement mailed 09 April 2002 (Paper No. 18), Applicants elect, with traverse, the claims of group I (Claims 1-3, 10-13, 21, 23-25, and 27) for prosecution in the subject application.

The restriction requirement is based, in part, upon the Examiner's contention that "[i]nventions II-IV, and I are related as combination and subcombination" as per M.P.E.P. § 806.05(c). Paper No. 18 at page 4. Applicants respectfully traverse.

As a preliminary matter, Applicants respectfully direct the Examiner's attention to the fact that claims 21 and 23 of proposed group I are not drawn to compositions. Rather, claims 21 and 23 are drawn to methods. Accordingly, Applicants request clarification of the Examiner's assertion that claims 21 and 23 "are drawn to a composition." Paper No. 18 at page 2.

Turning to the merits of the Examiner's contention, the attention of the Examiner is respectfully directed to the fact that, in combination/subcombination type restrictions, a burden rests upon an Examiner "to suggest an example of separate utility." M.P.E.P. § 806.05(c). In the instant case, the Examiner, merely by rendering the statement that the "subcombination has separate utility such as indicated in invention groups V-VII," has failed to meet that burden. Hence, Applicants assert that claims 1-3, 10-13, 21, 23-25, and 27 of the proposed group I, claims 1-11, 24, 25, and 28 of the proposed group II, claims 24-26 of the proposed group III, and claims 24, 25, and 29 of the proposed group IV should be examined together on the merits.

The restriction requirement is also based, in part, upon the Examiner's contention that

"[i]nventions V-VII are unrelated" as per M.P.E.P. §§ 806.04 and 808.01. Paper No. 18 at page 4. Applicants respectfully traverse.

As a preliminary matter, Applicants respectfully direct the Examiner's attention to the fact that claim 24 of proposed group VI is not drawn to a method. Rather, claim 24 is drawn to a composition. Accordingly, Applicants request clarification of the Examiner's assertion that claim 24, like claims 21 and 23, is "drawn to an *in vivo* method for eliciting an immunogenic response." Paper No. 18 at page 3.

Turning to the merits of the Examiner's proposed restriction with respect to proposed groups V-VII under M.P.E.P. § 808.01, Applicants note that inventions may be restricted under M.P.E.P. § 808.01 only if the inventions claimed "are not connected in design, operation, or effect under the disclosure of the particular application under consideration (M.P.E.P. § 806.04)." M.P.E.P. § 808.01. This situation, according to the M.P.E.P., "is but rarely presented, since persons will seldom file an application containing disclosures of independent things." *Id.* Indeed, the M.P.E.P. suggests that an Examiner may restrict an invention under M.P.E.P. § 808.01 only if the inventions are as unrelated as "a necktie and a locomotive bearing." *Id.*

In the instant case, the claims of proposed groups V-VII relate to methods involving the use of compositions comprising nucleocapsid protein monomers. The Examiner has presented no argument that the methods represented by proposed groups V-VII are significantly disparate. Hence, Applicants respectfully request that the Examiner consider the claims of proposed groups V-VII together on the merits.

The restriction requirement is also based, in part, upon the Examiner's contention under M.P.E.P § 806.05(f) that "the product of group II could be made with a different process, and the process of group VII could be used to make another materially different substance, such as a recombinant nucleocapsid protein monomers [sic] derived from human HBV." Paper No. 18 at page 5. Applicants respectfully traverse.

The Examiner's assertion that "the product of group II could be made with a different process," standing alone and without some explanation of a specific process, renders the Examiner's reasons for the proposed restriction vague. M.P.E.P § 806.05(f) suggests that an Examiner must specifically identify any alternate process by which a claimed product may be manufactured. Hence, Applicants respectfully request that the Examiner either (a) explicitly

state the process to which the Examiner desires to refer in support of the restriction requirement so that Applicants may understand and appropriately respond to the Examiner's proposals for restriction or (b) withdraw the requirement for restriction.

Further, Applicants note that it is proper for an Examiner to require restriction among patentable inventions only if search and examination of an entire application would present a "serious burden" to the Examiner. M.P.E.P. § 803. Applicants respectfully assert that simultaneous examination of the inventions of proposed groups I-VII would not present a serious burden to the Examiner. Indeed, Examiner Drabik, the predecessor of the current Examiner in the instant case, examined all of the inventions of proposed groups I-VII and issued an Office Action (Paper No. 12) with respect to said inventions. Hence, Applicants request withdrawal of the present requirement for restriction.

Applicants, of course, reserve the right to file divisional applications covering the subject matter of the non-elected claims. Receipt of an Office Action on the merits is awaited.

Respectfully submitted,

Dated: 8 May 2002

Don J. Pelto
Reg. No. 33,754

McKenna & Cuneo, LLP
1900 K Street, NW
Washington, DC 20006-1108
202.496.7842 (voice)
202.496.7756 (facsimile)